

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Janusz Blaszczyk et al.
Application No. : 10/666,919
Filed : September 18, 2003
For : FUEL CELL SYSTEM WITH FLUID STREAM RECIRCULATION

Examiner : Jonathan S. Crepeau
Art Unit : 1745
Docket No. : 130109.484
Date : September 21, 2006

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT WITH TRAVERSE

Commissioner for Patents:

By Office Action mailed September 1, 2006, the Examiner has entered a three-way restriction requirement; namely, Group I – claims 1-19, 22 and 23, drawn to an electric power generation system; Group II – claims 20 and 21, drawn to a method; and Group III – claims 24-27, drawn to a pressure regulator. In response, Applicants hereby elect, with traverse, the Group I claims (*i.e.*, claims 1-19, 22 and 23) for examination at this time. In addition, in view of the following remarks, Applicants request that the Restriction Requirement between the Group I and Group II claims be withdrawn and all such claims (*i.e.*, claims 1-23) be examined.

Restriction Can Be Proper In Limited Circumstances

An application may properly be restricted to one of two or more claimed inventions if they are able to support separate patents and they are either *independent* or *distinct*. However, if a search and examination of an entire application can be made *without serious burden*, the Examiner *must* examine it on the merits, even though it includes claims to independent or distinct inventions. MPEP 803.

The Claims Are So Related As To Present No Serious Burden To The Examiner

Applicants are unable to discern how searching both the Group I and Group II claims would present a *serious burden* to the Examiner. In this regard, Applicants note that the Group II claims are directed to methods of operating electric power generation systems of Group I. It appears, the Examiner is relying on the separate classification of such claims (*i.e.*, Group I in class 429, subclass 25, and Group II in class 429, subclass 17) to demonstrate the requisite *serious burden*. In other words, the Examiner is contending that while searching the electric power generation system claims (Group I), he would not search art classes that cover methods for operating such systems (*e.g.*, class 429, subclass 17). Similarly, the Examiner is contending that while searching the claims covering methods for operating an electric power generation system (Group II), he would not search art classes that cover the electric power generation system itself (*e.g.*, class 429, subclass 25).

Applicants disagree with the foregoing contention by the Examiner. As an initial matter, Applicants note that subclasses 17 and 25 of class 429 are both part of subclass 12 of class 429. From past experience, it is likely that in addition to art classes covering the claimed electric power generation systems (noted by the Examiner as class 429, subclass 25), the Examiner *will* likely look to art classes covering the claimed methods for operating such systems (noted by the Examiner as class 429, subclass 17) and *will* rely on references from such art classes to reject the system claims. Similarly, in addition to the art classes covering the claimed methods for operating an electric power generation system, the Examiner *will* likely look to the art classes encompassing such systems and *will* rely on such art in rejecting claims directed to such methods. Thus, as a practical matter, examining the claims of Groups I and II together does not appear to create a serious burden.

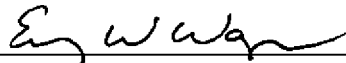
Summary

In making the above arguments, Applicants do not admit that any of the independent claims are obvious in light of one another. Applicants further do not admit that the classes indicated by the Examiner are appropriate for search should the Examiner persist in the restriction requirement. In light of the foregoing remarks, Applicants respectfully request that the Restriction Requirement between the Group I and Group II claims be withdrawn and all such claims (*i.e.*, claims 1-23) be examined.

Respectfully submitted,

Janusz Blaszczyk et al.

Seed Intellectual Property Law Group PLLC



Emily W. Wagner

Registration No. 50,922

EWV:cw

701 Fifth Avenue, Suite 6300
Seattle, Washington 98104-7092
Phone: (206) 622-4900
Fax: (206) 682-6031

834404_1.DOC